

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ALLAN HERROD, JOHN KLEIN,
SAROSH VESUNA, and SIMON BARD

Appeal 2007-3783
Application 10/057,463¹
Technology Center 2600

Decided: December 11, 2007

Before JOSEPH L. DIXON, JAY P. LUCAS, and SCOTT R. BOALICK,
Administrative Patent Judges.

LUCAS, *Administrative Patent Judge.*

DECISION ON APPEAL

¹ Application filed January 24, 2002. Application is a divisional of 08/906,722 filed 8/5/97, now patented. The real party in interest is Symbol Technologies, Inc.

STATEMENT OF CASE

Appellants appeal from a Final Rejection of claims 75 to 92, 95, and 96 under authority of 35 U.S.C. § 134. The Board of Patent Appeals and Interferences (BPAI) has jurisdiction under 35 U.S.C. § 6(b).

Appellants' invention relates to a device for providing a user with a terminal that gives product information in a store, such as a retail store. In the words of the Appellants:

Independent claim 75 recites a product location information retrieval system in a retail establishment comprising a computer terminal with an optical reader arranged to receive a data input query from the customer utilizing the terminal and relating to one or more products located in a product access zone, a remote link that receives a wireless signal from an access point and transmits the wireless signal to the computer terminal, wherein the wireless signal is associated with information relating to the one or more products within the product access zone; and a display that presents an image of the one or more products to be accessed by the user, the image is based at least in part upon the wireless signal. (*See e.g.* page 21, line 8 - page 23 line 8).
(Brief, Page 2, § V (A))

Claim 75 is exemplary:

75. A product location information retrieval system in a retail establishment comprising:

a computer terminal with an optical reader arranged to receive a data input query from the customer utilizing the terminal and relating to one or more products located in a product access zone;

a remote link that receives a wireless signal from an access point and transmits the wireless signal to the computer terminal, wherein the wireless

signal is associated with information relating to the one or more products within the product access zone; and

a display that presents an image of the one or more products to be accessed by the user, the image is based at least in part upon the wireless signal.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Copland	US 5,717,430	Feb. 10, 1998
Soltesz	US 5,756,978	May 26, 1998
Azar	US 5,778,177	Jul. 07, 1998
Yamamoto	US 5,991,276	Nov. 23, 1999
Durbin	US 6,039,258	Mar. 21, 2000

Rejections:

Claims 75, 77, 78, 95, and 96 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Azar.

Claims 76, 80-87, and 92 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Azar in view of Durbin.

Claims 79 and 88 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Azar in view of Yamamoto.

Claims 89 and 90 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Azar in view of Soltesz.

Claim 91 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Azar in view of Copland.

Appellants contend that the claimed subject matter is not anticipated by Azar, or rendered obvious by Azar alone, or in combination with the other references, for failure of the references to teach claimed limitations. The Examiner contends that the claims are properly rejected.

Rather than repeat the arguments of Appellants or the Examiner, we make reference to the Briefs and the Answer for their respective details. Only those arguments actually made by Appellants have been considered in this decision. Arguments which Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2004).²

We affirm the rejections.

ISSUE

The issue is whether Appellants have shown that the Examiner erred in rejecting the claims under 35 U.S.C. §§ 102(e) and 103(a). The issue turns on whether the references provide a teaching related to the limitation “a computer terminal ... arranged to receive a data input query from a customer relating to one or more products located in a product zone” and

² Appellants have not presented any substantive arguments directed separately to the patentability of the dependent claims or related claims in each group, except as will be noted in this opinion. In the absence of a separate argument with respect to those claims, they stand or fall with the representative independent claim. *See In re Young*, 927 F.2d 588, 590 (Fed. Cir. 1991).

“wherein the wireless signal is associated with information relating to the one or more products within the product access zone”.

FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence.

1. Appellants have invented a system wherein a user (customer) with access to a computer terminal with an optical reader receives, in response to his query, information on products located in the retail establishment near the user in an area called his product access zone. (See Figure 5, and Spec. 21, l. 8+). A remote link installed in that computer terminal (Spec. 21, l. 29) receives a wireless signal containing the information requested by the user, where an image of the product based on the wireless signal is displayed. (Figure 6, Spec. 21, bottom).
2. The reference Azar, cited in all the rejections, teaches end user stations (#1) containing scanning devices (#10) and input devices (#11a,b), which stations contain remote links (communication interface #15) for displaying product information to the user. In one example related to shopping for apparel (column 3, bottom paragraph), the user uses the terminal to send their size information to the vendor, and receives in return a “three- dimensional image of the article of clothing as it would look on the customer”.

PRINCIPLES OF LAW

On appeal, Appellants bear the burden of showing that the Examiner has not established a legally sufficient basis for the rejection of the claims.

“In reviewing the [E]xaminer’s decision on appeal, the Board must necessarily weigh all of the evidence and argument.” *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

“To reject claims in an application under section 103, an examiner must show an unrebutted *prima facie* case of obviousness On appeal to the Board, an applicant can overcome a rejection by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.” [citations removed] *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998).

It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim. *See In re King*, 801 F.2d 1324, 1326 (Fed. Cir. 1986) and *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458 (Fed. Cir. 1984).

Our reviewing court states in *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989) that “claims must be interpreted as broadly as their terms reasonably allow.” Our reviewing court further states that “the words of a claim ‘are generally given their ordinary and customary meaning.’” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc) (internal citations omitted). The “ordinary and customary meaning of a claim term is the

meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application." *Id.* at 1313.

However, our reviewing court has held that nonfunctional descriptive material cannot lend patentability to an invention that would have otherwise been anticipated by the prior art. *In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004). *Cf. In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability).

This case, however, is dissimilar from *Gulack*. There the printed matter and the circularity of the band were interrelated, so as to produce a new product useful for ‘educational and recreational mathematical’ purposes. Here, addition of a new set of instructions into a known kit does not interrelate with the kit in the same way as the numbers interrelated with the band. In *Gulack*, the printed matter would not achieve its educational purposes without the band, and the band without the printed matter would similarly be unable to produce the desired result. Here, the printed matter in no way depends on the kit, and the kit does not depend on the printed matter. *In re Ngai*, 367 F.3d at 1339 (Fed. Cir. 2004).

More than mere abstraction, data structures are specific electrical or magnetic structural elements in a memory. In *In re Lowry*, the data structures provide tangible benefits: data stored in accordance with the claimed data structures are more easily accessed, stored, and erased. The opinion further notes that, unlike prior art data structures, Lowry's data

structures simultaneously represent complex data accurately and enable powerful nested operations. In short, Lowry's data structures were found to be physical entities that provide increased efficiency in computer operation. They are not analogous to printed matter. *In re Lowry*, 32 F.3d 1579, 1583 (Fed. Cir. 1994).

ANALYSIS

From our review of the administrative record, we find that the Examiner has presented a prima facie case for the rejections of Appellants' claims under 35 U.S.C. §§ 102 and 103. The prima facie case is summarized on pages 3 to 7 of the Examiner's Answer.

Rejection of Claims 75, 77 to 78, 95 and 96 under 35 U.S.C. § 102(e)

In opposition to the prima facie case, Appellants present two main arguments. The first argument contends that the Azar reference fails to provide a teaching related to the limitation "a computer terminal ... arranged to receive a data input query from a customer relating to one or more products located in a product zone." Appellants' second argument is that the reference does not teach the limitation "wherein the wireless signal is associated with information relating to the one or more products within the product access zone." (Brief, Page 4, middle).

Sometimes it is best, after the arguments by both sides go back and forth, to simply analyze the language of the claim again in view of the reference.

Claim 75 requires a product location information retrieval system. The Azar device helps the user locate products – see column 3, bottom paragraph. The limitation in the preamble of “in a retail establishment” is not linked to any functionality in the claim structure, and does not have patentable weight. (See *In re Lowry*, cited above). Moreover, even if that limitation were given weight, Azar describes the system in a clothing vendor (i.e., retail) setting as discussed above (bottom of col. 3).

Azar teaches a computer terminal with an optical reader and input devices, arranged to receive data input queries. (FF 2). If we grant weight to the nature of the query, which is a question of law to be determined, we could read the “query related to products in an access zone” on Azar’s query concerning apparel on clothing from the vendor’s market. (Col. 3, bottom). The product access zone is not constrained by the claim to any particular location, and the term can be read broadly, but fairly, on any access location for the product.

The claimed remote link is contained in the terminal (FF2), and receives a wireless signal from the access point (the vendor’s market) associated with information relating to one or more products within the product access zone (the articles of clothing).

The claimed display (FF2) presents an image of the products (col. 3, l. 67) based on the wireless signal (*id.*).

Though Azar teaches the limitations of this claim, as noted just above, we are mindful of the lessons concerning non-functional descriptive material stated in *In re Ngai* (cited above). Without a functional recitation in the claim in which the nature of the query or the content of the wireless signal plays a role, we would be hard pressed to give patentable weight to the recited nature of the query or the content of that signal. However, we note that in this case Azar does teach a query as claimed, and a signal associated with information, as claimed.

With this in mind, we find that the Examiner did not err in rejecting the cited claims under 35 U.S.C. § 102(e).

Rejections under 35 U.S.C. § 103(a)

Appellants have not presented separate and distinct arguments against these rejections, but have relied upon the arguments discussed above in relation to the rejection under 35 U.S.C. § 102(e) over Azar (App. Br. 5 to 7). In view of the conclusions recited just above, we similarly find no error in the Examiner's rejections under 35 U.S.C. § 103(a), as listed in the Statement of the Case above.

CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that the Examiner did not err in rejecting claims 75 to 92, 95, and 96. The rejection of those claims is affirmed.

DECISION

The Examiner's rejection of claims 75 to 92, 95, and 96 is affirmed.

AFFIRMED

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